

REMARKS

This reply is fully responsive to the Office Action dated 05/31/2007, and is filed within six - (6) months following the mailing date of the Office Action. The Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed. The method of payment and fees for petition fee due in connection therewith is enclosed.

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Disclosure/Claims Status Summary:

This application has been carefully reviewed in light of the Office Action of May 31, 2007, wherein:

- A. Claims 1-16 were rejected under 35 USC § 112, first paragraph;
- 15 B. Claims 2-3, 6, 10-11, 14, and 16 were rejected under 35 USC 112, second paragraph;
- C. Claims 1-2, 4-10, and 12-16 were rejected under 35 USC 102(e) as being anticipated by Copperman et al. (U.S. Patent No. 6,711,585 B1; henceforth referred to as the Copperman patent); and
- 20 D. Claims 3, and 11 were rejected under 35 USC 103(a) as being unpatentable over the Copperman patent in view of Lang and M. Burnett. *Knowledge-Based Systems. XML, metadata and efficient knowledge discovery*. Pub. 2000. Elsevier Science B.V. (henceforth referred to as the Lang reference).

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Claim Rejections - 35 USC § 112**A. Claims 1-16 are rejected under 35 USC § 112, first paragraph**

The Examiner rejected Claims 1-16 for failing to comply with the enablement requirement. The Examiner asserted that “the claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the

invention.” The Examiner stated that the Applicant’s specification uses identical terminology to the claim language in stating the components of the instant invention (independent claims 1 and 9: first processing element, second processing element, etc.) without any further support, explanation, or examples as to what those components are.

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The Applicants respectfully direct the Examiner’s attention to page 6, lines 2-4 of the originally filed application in which the first processing element and second processing are described. “The apparatus configured to perform the steps could include a standard personal computer or other apparatus having the adequate processing power.” The 10 various elements and interrelationships of the present invention would be readily recognized by one having ordinary skill in the art. In particular, the discussion of FIG. 1 provides a thorough description of the overall architecture of the metadata extraction system. Since the claimed elements are discussed in enough detail within the specification as to enable one having ordinary skill in the art to practice the present 15 invention, the Applicants respectfully request that the Examiner withdraw his rejection under 35 USC § 112 first paragraph.

B. Claims 2-3, 6, 10-11, 14, and 16 are rejected under 35 USC § 112, second paragraph

20 The Examiner stated that the claims recite the word “substantially” prior to the only example of the subject matter requiring the description in both the claim language and the specification. The Examiner added: that it was unclear how something can be “substantially” format invariant or “substantially” spatial layout facts; that the files are either of the form containing invariant format or not; and that the predetermined 25 information is either spatial layout facts or not. The Examiner concluded that the term “substantially” renders the claims indefinite.

The Applicants respectfully disagree. The Applicants contend that the word “substantially” is a commonly used term in claim language. For example, a search 30 through a patent database (i.e., Delphion) reveals 992,233 issued U.S. patents with the word “substantially” in the claims. Thus, the inclusion of the word is clearly not

indicative of indefiniteness, unless a plethora of Patent Examiners were previously wrong in issuing nearly a million patents with the word “substantially” within the claims.

- As commonly used by one skilled in the art of claim drafting, the word “substantially”
- 5 provides for a degree of unintended error. Upon a review of the patent database, it should become readily clear that “substantially” is a common and accepted term for use in claims. Thus, unless the Examiner intends to go against commonly accepted patent prosecution principles, the Applicants assert that the use of the term does not render the claims indefinite and respectfully request that the Examiner withdraw this rejection.
- 10 However, should the Examiner find that claims are allowable, with the exception of the term “substantially,” the Examiner is encouraged to contact the Applicant’s representative (via phone or e-mail) to discuss a possible Examiner’s amendment in removing the term from the claims to provide for timely allowance.
- 15 Regarding Claims 8 and 16, the Examiner stated that both claims introduce a “storage medium” for storing metadata. However, the Examiner stated that it is not clear if the “storage medium” is the same as the database introduced by Claims 1 and 9.

The Applicants are confused. Claims 8 and 16 simply claim that the “metadata is

20 provided to a storage medium.” To one skilled in the art, the “storage medium” is a different word than “database” and clearly can operate as a separate, stand alone item for storing data. Although one may desire to use the database as the storage medium, that is not a claim limitation and is therefore inconsequential with respect to these claims, as they merely claim that the metadata is provided to a storage medium. Nothing depends

25 from either Claim 8 or Claim 16, thus there is no effect on the remaining claims. As this is clear to one skilled in the art, the Applicants respectfully request that the Examiner withdraw this rejection.

Claim Rejections - 35 USC § 102**C. Claims 1-2, 4-10, and 12-16 are rejected under 35 USC § 102(e) as being anticipated by the Copperman patent**

5 The Applicants assert that the Copperman patent and its priority date of June 15, 2000, does not qualify as prior art under the provisions of 35 USC § 102(e).

The cited prior art does not establish a prima facie case of anticipation.

10 In order to establish a prima facie case of anticipation the Examiner must set forth an argument that provides (1) a single reference (2) that teaches or enables (3) each of the claimed elements (as arranged in the claim) (4) either expressly or inherently and (5) as interpreted by one of ordinary skill in the art. All of these factors must be present, or a case of anticipation is not met.

15 The Applicants assert that the Examiner has failed to establish a single reference that teaches or enables each of the elements of the claimed invention. Specifically the Applicants submit that the Examiner has failed to set forth a prima facie case of anticipation because Applicants firmly believe that that the present invention was conceived prior to the publication date of the Copperman patent, and as such, 20 the Copperman patent should not be considered prior art with respect to the present invention.

25 To overcome a 35 USC § 102(e) rejection, the Applicants, or Assignee when the inventors are unavailable to make such a Declaration on their own behalf, may antedate a reference which qualifies as prior art under 35 USC § 102(e), where the reference has a prior art date under 35 USC § 102(e) prior to Applicants' effective filing date, and shows but does not claim the same patentable invention.

30 37 CFR 131(b) has been further reproduced for the Examiner's reference: *The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective*

date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

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The Applicants wish to direct the Examiner's attention to Appendix A which contains a declaration under 37 C.F.R. 1.131 which has been signed on behalf of the unavailable inventors by a representative of the Assignee, HRL Laboratories. The present invention has been shown to have been actually reduced to practice at least as early as May of 10 1999, within the United States and prior to the earliest effective date of the Copperman patent. Thus, the Applicants believe that in view of the 37 C.F.R. 1.131 declaration, the Copperman patent can no longer be considered as prior art with respect to the present invention.

15 Further it has been held that waiting on an attorney to draft and file a patent application is diligent. Reasonable diligence is all that is required of the attorney. *Bey v. Kollonitsch*, 866 F.2d 1024, 231 USPQ 967 (Fed. Cir. 1986). Reasonable diligence is established if the attorney worked reasonably hard on the application during the continuous critical period. See *id.* If the attorney has a reasonable backlog of unrelated cases which he 20 takes up in chronological order and carries out expeditiously, that is sufficient. See *id.* “[I]t is of no moment that the end of that period [for diligence] is fixed by a constructive, rather than an actual, reduction to practice.” *Justus v. Appenzeller*, 177 USPQ 332, 340-41 (Bd. Pat. Inter. 1971).

25 As applied to the present case and as authenticated with the signature below, the Applicants' attorney was in the process of preparing the patent application during the time between the actual reduction to practice and the filing date. During the time between the actual reduction to practice and the filing of the present invention, the Applicants' attorney had a reasonable backlog of unrelated cases and took up the cases in 30 chronological order and diligently and expeditiously carried out the cases until their

respective filing dates. Thus, the present application was diligently prepared by the attorney until its filing date.

Therefore, the Applicants respectfully request that the Examiner withdraw this rejection

5 under 35 USC § 102(e) and provide for timely allowance of Claims 1-2, 4-10, and 12-16.

Claim Rejections - 35 USC § 103

D. Claims 3 and 11 are rejected under 35 USC 103(a) as being unpatentable

10 **over the Copperman patent in view of the Lang reference**

The Examiner has misinterpreted the combination of the Copperman patent and the Lang reference to teach all of the limitations of Claim 3 and 11.

The Copperman patent should not be considered prior art with respect to the

15 **present invention**

As stated above, the Applicants wish to direct the Examiner's attention to Appendix A which contains a Declaration under 37 C.F.R. 1.131 which has been signed by an authorized representative of the Assignee on behalf of the unavailable inventors. The 20 present invention has been shown to have been actually reduced to practice at least as early as May of 1999, within the United States and prior to the earliest effective date of the Copperman patent. Thus, the Applicants believe that with the §1.131 declaration, the Copperman patent can no longer be considered prior art with respect to the present invention. Therefore, as the Examiner has relied on a patent which does not qualify as 25 prior art under 35 USC § 102(e), the Copperman patent in any combination does not constitute a *prima facie* case of obviousness. Therefore, the Applicants respectfully request that the Examiner withdraw this rejection under 35 U.S.C. § 103(a) and provide for timely allowance of Claims 3 and 11.

30 Furthermore, as noted above, the Applicants submit that Claims 1 and 9 are patentable.

The Applicants submit that Claims 3 and 11 are also patentable over the cited art, at least

based on their dependence upon an allowable base claims (Claim 1 and 9 respectively), and therefore respectfully request reconsideration and allowance of these claims.

CONCLUDING REMARKS:

The Applicants respectfully submit that, in light of the above amendments/remarks, the application and all pending claims are now in allowable condition. Therefore, reconsideration is respectfully requested. Accordingly, early allowance and issuance of

5 this application is respectfully requested.

Any claim amendments that are not specifically discussed in the above remarks are not made for patentability purposes, and it is believed that the claims would satisfy the statutory requirements for patentability without the entry of such amendments. Rather,

10 these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those skilled in the art to clearly understand the scope of the claim language. Furthermore, any new claims presented above are of course intended to avoid the prior art, but are not intended as replacements or substitutes of any cancelled claims. They are simply additional specific statements of

15 inventive concepts described in the application as originally filed.

Further, it should be noted that amendment(s) to any claim is intended to comply with the requirements of the Office Action in order to elicit an early allowance, and is not intended to prejudice Applicant's rights or in any way to create an estoppel preventing

20 Applicant from arguing allowability of the originally filed claim in further off-spring applications.

In the event the Examiner wishes to discuss any aspect of this response, or believes that a conversation with either Applicant or Applicant's representative would be beneficial, the

25 Examiner is encouraged to contact the undersigned at the telephone number indicated below.

The Commissioner is authorized to charge any additional fees that may be required or credit overpayment to the attached credit card form. In particular, if this response is not

30 timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of

the number of months necessary to make this response timely filed. The petition fee due in connection therewith may be charged to deposit account no. 50-2738 if a credit card form has not been included with this correspondence, or if the credit card could not be charged.

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10 Date

10/29/07

Respectfully submitted,



Cary Tope-McKay

Registration No. 41,350

15 Cary Tope-McKay
TOPE-MCKAY & ASSOCIATES
23852 Pacific Coast Highway #311
Malibu, CA 90265
Tel: 310-589-8158
Mobile: 310-383-7468
Fax: 310-943-2736
20 E-mail: cmckay@topemckay.com

Attachments: Appendix A; Declaration under 1.131